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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,402	03/22/2001	Jaspreet Singh	11710-0210 (44043-228530)	3828

7590 01/12/2006

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EXAMINER	
STEPHENS, JACQUELINE F	
ART UNIT	**PAPER NUMBER**
3761	

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/814,402	SINGH ET AL.	
	Examiner	Art Unit	
	Jacqueline F. Stephens	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 June 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,10-45 and 48-67* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7, 10-45, 48-67* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/3/05 have been fully considered but they are not persuasive. Regarding the rejection of claims 15-17, 19, 20, 22-24, 30-35, 37, 39, 40-45, 48-49, and 50-54 as being anticipated by Veith USPN 5516569, applicant's arguments are not persuasive. Applicant argues Veith provides evidence that the product of the present invention is not the same as the product of Veith et al. Applicant cites Table 1 of the present disclosure as demonstrating that as the amount of superabsorbent material increases, the shakeout value generally decreases. Applicant cites Table 1 of Veith et al. as demonstrating that as the amount of superabsorbent material increases, the shakeout value also generally increases. However, the cited sections are not equivalent in correlating a relationship between superabsorbent content and shakeout values. Veith, specifically, teaches shakeout value as result effective variable of different concentrations of wood pulp fluff, absorbent material, the percent of water added to the web, and the shape of the superabsorbent particulate material (col. 13, lines 19-60). Therefore, the argument that the trends are contrary to one another and that Veith produces a different product is not persuasive as Veith discloses other factors affect the shakeout value.

As to the rejection of claims 1-7 and 10-14 under 35 U.S.C. 103(a) as being unpatentable over Assarsson USPN 3901236 in view of Oczkowski USPN 4354487,

applicant's arguments are not persuasive. Applicant argues the Comparative Example 2 was produced in accordance with the teachings of Assarsson, i.e. the fibers are coated onto superabsorbent materials, dried and incorporated into a web and the comparative results show the example made according to Assarsson does not produce the same results as the present invention. In fact, applicant argues the Example 2 shows as the superabsorbent material increases, the shakeout value increases. As explained above with relation to the compararison of the Veith reference, the comparative results do not show a side by side comparison of the cited prior art. Assarsson teaches coating the superabsorbent prior to web formation. However, Assarsson also teaches various other factors affect the shake out values for example, the particle size, the manner in which the fibers are adhered to the superabsorbent, and the moisture content in the web all affect the ability of the web to retain the absorbent material. Furthermore, Assarsson teaches the general conditions of preventing shakeout of the absorbent material, col. 7, lines 20-28.

As to the rejection of claims 55-63 as being unpatentable over Veith, applicant's arguments are not persuasive. Veith discloses an upper limit of 85% superabsorbent. However, Veith does not teach against a value greater than 85%. Additionally, applicant has not disclosed criticality for a value of at least 90%. Furthermore, Veith teaches the general condition of preventing shake out. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the web of Veith with the claimed amount of superabsorbent, since where the

general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, In re Aller et al. 105 USPQ 233.

Claim Rejections - 35 USC § 102/103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 15-45, 48-54, 66, and 67 are rejected under 35 U.S.C. 102(b) as being anticipated by or in the alternative under 103(a) as being unpatentable over Veith USPN 5516569.

As to clams 15-17, 19, 20, 22-24, 26-28, 30-35, 37, 53, 54 66, and 67, Veith discloses a web comprising fibers and superabsorbent material, wherein the web comprises a superabsorbent material content of at least about 60% (Veith col. 2, lines 5-9). The superabsorbent of Veith bonds with the fibers in the web. (col. 5, lines 38-48). Veith discloses combinations of superabsorbent in the web (col. 3, lines 16-51).

The limitations directed to the web formation and the removal of liquid is directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the

product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claims 18, 21, 25, 29, 36, and 38 Veith discloses an absorbent article comprising the web (Veith col. 8 lines 27-32).

As to claim 39, a web comprising fibers and at least one superabsorbent material at least partially coated with the fibers, wherein individual bodies of the superabsorbent material have bonds with each other, with fibers that are coated upon other bodies of the superabsori ent material, or with a combination thereof, and the superabsorbent material comprises a composition that forms such bonds upon removal of a liquid contained in the superabsorbent material', wherein the bonds can form upon removal from the superabsorbent material of at least about 0.5 grams of the liquid per gram of superabsorbent material (Veith col. 2 lines 5-34). The limitation of the web formation is directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product

was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claim 40, Veith discloses an absorbent article comprising the web of Claim 39. (Veith col. à lines 27-32).

As to claims 41-43, 49, and 50, these limitations are directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claim 44, see col. 4, lines 43-48.

As to claim 45, Veith does not disclose the liquid comprises distilled water. However, it would be obvious to one skilled in the art at the time the invention was made to use distilled water since distilled water is commonly used in laboratories and in processing in manufacture.

As to claim 48, see col. 2, lines 60-67.

As to claim 51, see col. 5, lines 10-15.

As to claim 52, see col. 3, lines 51-52.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-7 , 10-14, 65, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Assarsson USPN 3901236 in view of Oczkowski USPN 4354487.

As to claim 1, 64, and 65, Assarsson discloses a web comprising superabsorbent material and fibers wherein at least some of the fibers are coated onto the superabsorbent material prior to formation of the web (See for example Assarsson col. 4 lines 49-50., col. 5 lines 41-44, the web is formed while the superabsorbent material contains a liquid that it has absorbed (Assarsson col. 5 lines 47-49 wherein swelling hydrogen indicates

absorbency), and at least some of the liquid absorbed in the superabsorbent is material is removed after formation of the web (Assarsson col. 8 lines 66-68).

The limitation of the web formation is directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

The Shakeout Test is determined by performing a test set forth in the application. Therefore the claims also define the invention by processes of manufacture, which require tests used to determine the test characteristics, and thus, the claims are product by process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in

the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claim 2, Assarsson discloses an absorbent article comprising the web of claim 1 (Assarsson col. 7 lines 62-68).

As to claims 3-5, 11 and 12, these limitations are directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claim 6, Assarsson discloses the liquid is selected from solutions that comprise water (col. 5, lines 47-49).

As to claim 7, Assarsson discloses the liquid is aqueous (col. 5, lines 47-49), but does not disclose the liquid comprises distilled water. However, it would be obvious to

one skilled in the art at the time the invention was made to use distilled water since distilled water is commonly used in laboratories and in processing in manufacture.

As to claim 10, Assarsson discloses a web according to Claim 1 , wherein the fibers comprise wood pulp fibers (col. 4 lines 29-39).

As to claim 13, Assarsson discloses the web comprises one or more fibers, particles, materials or combinations thereof in addition to the fiber and the superabsorbent material (col. 4 lines 13-46 disclosing mixtures of polymers, fibers and combinations', col. 7 lines 9-19 disclosing additives).

As to claim 14, Assarsson discloses the superabsorbent material comprises particles (col. 4, lines 24-28).

7. Claims 55-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Veith USPN 5516569.

As to clams 55, Veith discloses a web comprising fibers and superabsorbent material, wherein the web comprises a superabsorbent material content of at least about 60% (Veith col. 2, lines 5-9). Veith does not disclose a content of at least 90%. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the claimed superabsorbent content, since where the general conditions of a claim are disclosed in the prior art, discovering the optimum or

workable ranges involves only routine skill in the art. The Shakeout Test is determined by performing a test set forth in the application. Therefore the claims also define the invention by processes of manufacture, which require tests used to determine the test characteristics, and thus, the claims are product by process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claim 56, Veith discloses an absorbent article comprising the web (Veith col. 8 lines 27-32).

As to claim 57, see col. 4, lines 43-48.

As to claim 58, Veith does not disclose the liquid comprises distilled water. However, it would be obvious to one skilled in the art at the time the invention was made to use distilled water since distilled water is commonly used in laboratories and in processing in manufacture.

As to claim 59, see col. 2, lines 60-67.

As to claims 60 and 61, these limitations are directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the

process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claim 62, see col. 5, lines 10-15.

As to claim 63, see col. 3, lines 51-52.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jacqueline F Stephens
Examiner
Art Unit 3761

December 28, 2005